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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,718	10/22/2003	Andrew Tatta	Tatta-3	6848

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EXAMINER

MORRISON, NASCHICA SANDERS

ART UNIT PAPER NUMBER

3632

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/691,718

Applicant(s)

TATTA, ANDREW

Examiner

Naschica S Morrison

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This is the first Office Action for serial number 10/691,718, Mounting Device and Method for attaching an electronic toll pass assembly to a vehicle windshield, filed on October 22, 2003. Claims 1-15 are pending.

#### ***Claim Objections***

Claim 15 is objected to because of the following informalities: on line 9, "using the" after "structure" should be deleted. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6, line 1 states that the claim is dependent upon claim 51, which is not pending; thus the claim is indefinite. Therefore, claims 6 and 7 have not been further treated for prosecution on the merits.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,658,775 to Lanzisero in view of U.S. Patent Application Publication 2003/0066224 to Sumner, III et al. (Sumner) and further in view of U.S. Patent 4,848,542 to Burnette. Regarding claims 1, 3, 4 and 8, Lanzisero discloses a mounting device comprising: a support substrate (14) having a face surface (18) and a back surface (16); a fastener (28) disposed on the face surface to selectively attach the support substrate to a vehicle windshield; and a hook and loop fastener (62) coupled to the back surface (16) for selectively mounting an electronic toll pass (50) to the support substrate and windshield. Lanzisero does not teach the support structure being flexible or having an adhesive coating on the face surface. Sumner teaches a flexible support substrate (3) having a face surface with an adhesive coating (12) for selectively mounting the support structure to a windshield. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the support structure of Lanzisero to be flexible and to have substituted an adhesive coating for the fastener (28) because one would have been motivated to permit the mounting device to easily conform to a curved surface without sacrificing the ability of the mounting device to be securely fastened to the surface as taught by Sumner (paragraph 0009).

Lanzisero also fails to teach the face surface including a display image. Burnette teaches a mounting device (Fig. 2A) including a display image (at 22 generally) printed, adhered, or laminated to its surface. It would have been obvious to one of ordinary skill

in the art at the time the invention was made to have modified the face surface of the support substrate of Lanzisero to include a display image thereon because one would have been motivated to provide a means for advertising or other promotional purposes as taught by Burnette (col. 4, lines 31-33).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lanzisero in view of Sumner in view of Burnette and further in view of U.S. Patent 6,127,938 to Friedman. Regarding claim 2, Lanzisero in view of Sumner in view of Burnette discloses the mounting device as applied above, but Lanzisero does not teach the support substrate being opaque. Friedman teaches a mounting device (20) having an opaque support substrate (22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the support structure of Lanzisero to be opaque because one would have been motivated to conceal the electronic toll payment pass as taught by Friedman.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lanzisero in view of Sumner in view of Burnette and further in view of U.S. Patent 3,837,608 to Simon. Regarding claim 5, Lanzisero in view of Sumner in view of Burnette discloses the mounting device as applied above, but Lanzisero does not teach the support substrate having walls extending from the back surface. Friedman teaches a mounting device (30) having a support substrate (32) with walls (34) extending from a back surface thereon. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the support structure of Lanzisero to include

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walls extending from the back surface because one would have been motivated to enhance the gripping power of the mounting device as taught by Simon.

Claims 9 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Sumner. Regarding claims 9 and 13-15, Lanzisero mounting an electronic toll payment pass to a contoured vehicle windshield comprising: providing a support substrate (14) having a face surface (18) and a back surface (16), a fastener (28) disposed on the face surface to selectively attach the support substrate to a vehicle windshield, and a hook and loop fastener (62) coupled to the back surface (16); attaching the face surface to the windshield; and attaching the electronic toll pass (50) to the back surface (16) of the support substrate by interconnecting areas of hook and loop material (62) on the back surfaces of the support substrate and electronic toll payment pass, wherein the support substrate is interposed between the windshield and electronic toll payment pass. Lanzisero does not teach the support structure being flexible to conform to the windshield or being adhesively attached to the windshield. Sumner teaches attaching the face surface of a flexible support substrate (3) to a windshield using an adhesive (12) or double-sided tape (paragraph 0027), wherein the substrate conforms to the contour of the windshield. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the support structure of Lanzisero to be flexible and to have substituted an adhesive coating or double-sided tape for the fastener (28) because one would have been motivated to permit the mounting device to easily conform to a curved surface without sacrificing the

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ability of the mounting device to be securely fastened to the surface as taught by Sumner (paragraph 0009).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lanzisero in view of Sumner and further in view of Burnette. Regarding claim 10, Lanzisero in view of Sumner teaches the method steps as applied above, but does not teach the mounting device including a display image on the face surface. Burnette teaches a mounting device (Fig. 2A) including a display image (at 22 generally) printed or adhered to its surface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the face surface of the support substrate of Lanzisero to include a display image printed, adhered or laminated thereon because one would have been motivated to provide a means for advertising or other promotional purposes as taught by Burnette (col. 4, lines 31-33).

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lanzisero in view of Sumner in view of Burnette and further in view of U.S. Patent 4,858,869 to Stang. Regarding claims 11 and 12, Lanzisero in view of Sumner in view of Burnette teaches the method steps as applied above, but Lanzisero does not teach the flexible support substrate being formed of paperboard. Stang teaches a mounting device (Fig. 2A) formed of paperboard. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the support substrate of Lanzisero to be formed of paperboard to provide a lighter weight device and further since it has been held to be within the general skill of a worker in the art to select a

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known material on the basis of its suitability for the intended use as a matter of obvious design choice.


### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: 4184276 to Hernandez; 4605292 to McIntosh; 4989819 to Sigler; 5099594 to Reas et al; 5275367 to Frye; 5310999 to Claus et al; 5502912 to LeBoff et al; 5678793 to Hill; 5960572 to DeVito; 6142640 to Schofield; 6390429 to Brincat; 6405983 to Goj; 6446374 to Ardif; 6452507 to Friedman; 2003/0079392 to Newman; D477909 to Harris; 6663063 to Tatta; 6745925 to Bryzski

The above references disclose mounting devices relevant to the present invention.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 306-1113.

  
Naschica S. Morrison  
Patent Examiner  
Art Unit 3632  
9/17/04

  
RAMON O. RAMIREZ  
PRIMARY EXAMINER